

REMARKS

Anticipation Rejection of Claims 1, 2, 5-9, 11-13, and 19-21

At section 3 of the Office Action, claims 1, 2, 5-9, 11-13, and 19-21 were rejected under 35 U.S.C. Section 102(e) as being anticipated by Moore (U.S. Patent App. Pub. No. 2003/0039242). This rejection is respectfully traversed because Moore fails to disclose the particular combinations of features recited by claims 1, 2, 5-9, 11-13, and 19-21.

Rejection of Claims 1, 2, 5-7, 19, and 20

Claim 1, from which claims 2, 5-7, 19, and 20 depend, recites the features of receiving an internet protocol address associated with a wireless local area network base station and sending a call forwarding message including the internet protocol address from a mobile phone to a remote cellular network element of a wide area cellular network. The Office Action asserts that the passages of Moore at paragraphs 29, 32, 39, and 40 disclose these features. However, as discussed in the previous response mailed April 25, 2005, Moore teaches that the handset 10 receives the *telephone number* of the VoIP gateway 20 (which the Office appears to consider equivalent to a wireless local area network base station) and that the handset 10 sends "a command to the mobile telephone network 30 instruction to the mobile telephone network 30 to forward incoming telephone calls to the *telephone number* of the VoIP gateway 20." *See Moore*, para. 32.

Moore fails to disclose that the command sent by the handset 10 to the mobile telephone network 30 includes an internet protocol address of any kind, much less the internet protocol address associated with a wireless local area network base station as provided by claim 1. As also discussed in the previous response, one of ordinary skill in the art will appreciate that a telephone number and an internet protocol address are not the same and are not equivalent. A telephone number typically is used to identify the destination of a telephone communication over a public switched telephone network (PSTN), whereas an internet protocol address is used to identify a network node of a packet communication via an internet protocol (IP)-compliant network. Telephone numbers and internet protocol addresses therefore typically are not interchangeable. As an implicit acknowledgment of this fact, the Office Action sets forth an

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obviousness – type argument by stating that because “IP routers 44 may be notified of a new route for the handsets IP address to enable the forwarding of the IP data traffic via the VoIP network,” one skilled in the art “would unhesitatingly envision and conceptualize the step of receiving an internet protocol address . . . [and] sending a call forwarding message including the internet protocol address from the mobile phone to a remote cellular network element of a wide area cellular network (i.e., the handset sends a command to the mobile telephone network.”

Office Action, p. 3.

As a first issue, claim 1 is rejected as *anticipated* by Moore under 35 U.S.C. Section 102(e). The Office Action’s assertion that one skilled in the art “would unhesitatingly envision and conceptualize” features of claim 1 in view of Moore is improper in an anticipation rejection as the Office Action does not assert that these features are disclosed or inherent to the teachings of Moore. Such assertions would be more proper as an *obviousness* rejection under 35 U.S.C. Section 103(a). *See M.P.E.P.* § 706.02(IV). As a second issue, there is no motivation for such “unhesitating” envisioning and conceptualizing of sending a call forwarding message including the internet protocol address because Moore explicitly teaches that the calls are forwarded to a *telephone number* associated with the VoIP gateway 20 and Moore provides no disclosure or suggestion that the command includes the internet protocol address of the VoIP gateway 20. As Moore is absent such motivation, the use of an internet protocol address in addition to, or instead of, the telephone number explicitly taught by Moore could only be envisioned by one of ordinary skill in the art as the result of a hindsight reconstruction in view of the disclosure of the present application. Accordingly, it is respectfully submitted that Moore fails to disclose or even suggest the particular combination of features recited by claim 1, as well as the additional features recited by claims 2, 5-7, 19, and 20 at least by virtue of their dependency from claim 1. Reconsideration and withdrawal of the anticipation rejection of claims 2, 5-7, 19, and 20 therefore is respectfully requested.

Rejection of Claims 8, 9, 11-13, and 21

Claim 8, from which claims 9, 11-13, and 21 depend, recites the features of retrieving an internet protocol address and an optional port number associated with a wireless local area network base station from a memory, and sending the internet protocol address and optional port number over a wireless fidelity communication link to the mobile phone. The Office Action

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asserts that the passages of Moore at paragraphs 32, 37, 39, 40 and 42 disclose these features. Specifically, the Office Action asserts that because Moore allegedly discloses that "the handset 10 may dynamically be assigned a new IP address on an IP subnet of the VoIP gateway 20, and IP routers 55 may be notified of a new route for the handset's IP address to enable the forwarding of IP data traffic via the VoIP telephone network," the handset *inherently* receives a port number "so that the IP routers may be notified of the new route or path for the handset's IP address." *Office Action*, p. 5 (emphasis added). With respect to the use of inherent disclosures of a prior art reference, the M.P.E.P. provides that:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) (The claims were drawn to a disposable diaper having three fastening elements. The reference disclosed two fastening elements that could perform the same function as the three fastening elements in the claims. The court construed the claims to require three separate elements and held that the reference did not disclose a separate third fastening element, either expressly or inherently.).

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original) (Applicant's invention was directed to a biaxially oriented, flexible dilation catheter balloon (a tube which expands upon inflation) used, for example, in clearing the blood vessels of heart patients). The examiner applied a U.S. patent to Schjeldahl which disclosed injection molding a tubular preform and then injecting air into the preform to expand it against a mold (blow molding). The reference did not directly state that the end product balloon was biaxially oriented. It did disclose that the balloon was "formed from a thin flexible inelastic, high tensile strength, biaxially oriented synthetic plastic material." *Id.* at 1462 (emphasis in original). The examiner argued that Schjeldahl's balloon was inherently biaxially oriented. The Board reversed on the basis that the examiner did not provide objective evidence or cogent technical reasoning to support the conclusion of inherency.).

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M.P.E.P. § 2112 (emphasis added).

The Office Action fails to provide any compelling basis for the general assertion that provision of an optional port number is inherent to the disclosure of Moore. Thus, the Office Action fails to establish that the optional port number feature is “necessarily present” or “necessarily flows” from the teachings of Moore as is required to establish their inherency. *See In re Robertson; see also Ex parte Levy* (supra). Moreover, an attempt to establish that the features of sending an optional port number over a wireless fidelity communication link to a mobile phone as recited by claim 8 are inherent to the teachings of Moore would fail as the provision of an optional port number would not be necessarily present in the system disclosed by Moore. As one of ordinary skill in the art would identify numerous known techniques for establishing a communications path without requiring the provision of an optional port number, the features of sending an internet protocol address and optional port number over a wireless fidelity communication link to a mobile phone are not inherent to the teachings of Moore. Accordingly, it is respectfully submitted that Moore fails to disclose or even suggest the particular combination of features recited by claim 8, as well as the additional features recited by claims 9, 11-13, and 21 at least by virtue of their dependency from claim 8.

Moreover, dependent claims 9, 11-13, and 21 claims recite additional features neither disclosed nor suggested by Moore. For example, claim 9 recites the additional features of receiving a call from a wide area network, the call directed to the mobile phone *at the internet protocol address and the optional port number* of the wireless local area network base station. As disclosed by Moore, phone calls are directed to a telephone number associated with the VoIP gateway 20, rather than an internet protocol address and an optional port number. Reconsideration and withdrawal of the anticipation rejection of claims 8, 9, 11-13, and 21 therefore is respectfully requested.

Obviousness Rejections of Claims 3, 4, and 10

At section 5 of the Office Action, claims 3 and 10 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Moore in view of Reding (U.S. Patent App. Pub. No. 2004/0213212). At section 6 of the Office Action, claim 4 was rejected under 35 U.S.C. Section

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103(a) as being unpatentable over Moore in view of Shostak (U.S. Patent App. Pub. No. 2004/0127241). These rejections are respectfully traversed.

As noted above, Moore fails to disclose or suggest the features of sending a call forwarding message including an internet protocol address from a mobile phone to a remote cellular network element of a wide area cellular network as recited by claim 1 and the features of sending an internet protocol address and an optional port number over a wireless fidelity communication link to a mobile phone as recited by claim 8. The Office Action does not assert that either of Reding or Shostak discloses or suggests these features, nor are these features in fact disclosed or suggested by Reding or Shostak. Accordingly, the Office Action fails to establish that the proposed combinations of Moore, Reding and Shostak disclose or suggest the additional features of claims 3, 4 and 10 at least by virtue of their dependency from one of claims 1 or 8. Reconsideration and withdrawal of the obviousness rejections of claims 3, 4, and 10 therefore is respectfully requested.

Obviousness Rejection of Claims 14, 15, and 18

At section 7 of the Office Action, claims 14, 15, and 18 are rejected under 35 U.S.C. Section 103(a) as being unpatentable over Reding in view of Moore. This rejection is respectfully traversed

Contrary to the assertions of the Office Action, the proposed combination of Reding and Moore fails to disclose or suggest the particular combination of features recited by claim 14, from which claims 15 and 18 depend. To illustrate, claim 14 recites the features of a mobile phone device comprising a wide area cellular communication module that formulates a call forwarding message that includes an internet protocol address received from a wireless local area network, the call forwarding message to be communicated to a remote wide area cellular network. The Office Action acknowledges that Reding fails to disclose these features and instead relies on the teachings of Moore. However, as discussed above, Moore fails to disclose or suggest a call forwarding message that includes an internet protocol address as recited by claim 14. Accordingly, the proposed combination of Reding and Moore fails to disclose or suggest these features. Consequently, the Office Action fails to establish that the proposed combination of Reding and Moore discloses or suggest each and every feature recited by claim 14, as well as each and every feature recited by claims 15 and 18 at least by virtue of their

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dependency from claim 14. Reconsideration and withdrawal of this rejection therefore is respectfully requested.

Conclusion

It is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

The Commissioner is hereby authorized to charge any fees that may be required, or credit any overpayment, to Deposit Account Number 50-2469

Respectfully submitted,

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Date



Ryan S. Davidson, Reg. No. 51,596,
TOLER, LARSON & ABEL, L.L.P.
5000 Plaza On The Lake, Suite 265
Austin, Texas 78746
(512) 327-5515 (phone) (512) 327-5452 (fax)